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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,447	01/22/2002	James R. Keogh	P0009170.00	5485
27581	7590	03/19/2008		
MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MINNEAPOLIS, MN 55432-9924			EXAMINER BAGOPIAN, CASEY SHEA	
			ART UNIT	PAPER NUMBER
			1615	
			MAIL DATE	DELIVERY MODE
			03/19/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/054,447

Applicant(s)

KEOGH ET AL.

Examiner

CASEY HAGOPIAN

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 233, 273-276, 278-281 and 293-298 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 5-8, 233, 273, 274, 279, 293, 294 and 296 is/are allowed.
- 6) ☒ Claim(s) 4, 9, 10, 275, 276, 280, 281, 295, 297 and 298 is/are rejected.
- 7) ☒ Claim(s) 278 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of applicant's Request for Continued Examination/Amendment/Remarks filed 9/5/2007.

Claims 1, 233, 278, 279 are amended. Claims 293-298 are new. Claims 1-10, 233, 273-276, 278-281, 293-298 are currently pending.

MAINTAINED REJECTIONS

The following rejections are maintained from the previous Office Action dated 6/5/2007:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 10, 280 and 281 stand rejected and newly added claims 297 and 298 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims are drawn to a primer on the surface of the device. However the claims from which the instant claims depend (i.e., claims 1 and 233), contain a limitation describing the catechol moiety is disposed on the surface of the device. Thus, it is unclear how the catechol is disposed on the surface and then a primer is disposed on the same surface. Appropriate correction/clarification is respectfully requested.

Response to Arguments

Applicant's amendments render the rejection of claim 1-10, 276, 280 and 281 under 35 USC 112, 2nd paragraph moot in part. Specifically, the amendment renders the rejection of claims 1-8 and 276 moot, however claims 9, 10, 280 and 281 remain rejected. Applicant has not addressed how a catechol and a primer can both be disposed on the surface of the device. For these reasons, the rejection of claims 1-8 and 276 under 35 USC 112, 2nd paragraph is withdrawn and the rejection of claim 9, 10, 280 and 281 under 35 USC 112, 2nd paragraph is maintained. It is noted that newly added claims 297 and 298 have been added to said maintained rejection.

Applicant's amendment renders the art-based rejection of the claims under 35 USC 102 moot. Thus, said rejection has been withdrawn.

NEW OBJECTIONS/REJECTIONS

The following objections/rejections are new:

Claim Objections

Claim 278 is objected to under 37 CFR 1.75(c) as being in improper form because it does not depend from a preceding claim. See MPEP § 608.01(n)(I)(B)(2).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 275 and 295 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims include a Markush group of "biocompatible materials". Said Markush group includes "a metal" and follows with specific examples of metals. It is unclear what the meets and bounds of the claim are because applicant is claiming a very broad genus in combination with various species. Similarly, said Markush group includes "a polymer" and follows with specific examples of polymers. For the same reasons as discussed above, the claim is indefinite. Lastly, the limitation "a wood" is not regarded as a biocompatible material in the art. It is unclear how wood can be considered an acceptable biocompatible material.

Claim 276 recites the limitation "the hydrophilic polymer" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim. For proper antecedent basis, the limitation should read, "the naturally occurring hydrophilic polymer". Also, claim 276 recites synthetic polymers that do not fall into the category of "naturally occurring hydrophilic polymers". Thus, the claim does not properly further limit the claimed invention.

Correction is respectfully requested.

Conclusion

Claims 4, 9, 10, 275, 276, 280, 281, 295, 297 and 298 have been rejected and claim 278 is objected to. Claims 1-3, 5-8, 233, 273, 274, 279, 293, 294 and 296 appear

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to be allowable pending a patentability conference. The claims appear to be free of the art.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Casey Hagopian whose telephone number is 571-272-6097. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carlos Azpuru, can be reached at 571-272-0588. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Casey Hagopian/

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/Carlos A. Azpuru/

Primary Examiner, Art Unit 1615